

REMARKS

Claims 1-7, 10, 11, 14, 15, and 22-32 remain pending in the application. The claims have not been amended in response to the Office Action, but Claim 22 has been amended to correct minor clerical inconsistencies; Claims 30-32 are new; and Claims 2-7 are withdrawn from consideration at this time. Basis for the amendments and new claims can be found throughout the specification, claims and drawings as originally filed. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 10, 11, 14, 15, 22-25 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Viazanko** (U.S. Pat. No. 4,798,113) in view of **Brundage et al.** (U.S. Pat. No. 4,934,233) and Applicants' admitted prior art. **Claim 26 is rejected** under 35 U.S.C. § 103(a) as being unpatentable over the combination of **Viazanko** in view of **Brundage et al.** as applied to Claim 22, and further in view of **Novak** (U.S. Pat. No. 3,901,498). These rejections are respectfully traversed.

Applicants believe that the Examiner has not met the initial burden of factually supporting the *prima facie* case for obviousness under 35 U.S.C. § 103.

To reach a proper determination under 35 U.S.C. § 103, the Examiner must step back in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge

of applicant's disclosure must be put aside in reaching this decision to avoid resorting to "hindsight" based upon applicant's disclosure. Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis gleaned from the prior art.

To establish a *prima facie* of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine the teachings. Second, there must be a reasonable expectation for success. Finally, the prior art references must teach or suggest all of the claim limitations. The teaching of suggestion to make the claimed combination must be found in the prior art, and not based upon applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There are three possible sources for a motivation to combine references: the nature of the problem to be resolved; the teachings of the prior; and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

The Examiner relies on *Viazanko* to teach or suggest almost every structural limitation of the claimed invention; however, *Viazanko* lacks the cutting tool being movable to the second and third positions. The Examiner then takes Official Notice that cutting tools that are capable of such positions are old and well known in the art as evidenced by *Brundage et al.* For the record, *Brundage et al.* only moves to the second position and is not capable of being moved to the third position as defined by the claim.

Claim 1 defines the movable fences (first and second) are movable to provide clearance for said cutting tool when the cutting tool is in the second and third position.

The movable fences in **Viazanko** do not teach this limitation, **Viazanko** does not support the combination of combining admitted prior art, nor does it support the necessary modification of **Viazanko**.

Clearly in **Viazanko**, the fixed fences 20 and 22 provide clearances for the saw blade when it is moved to its miter positions. Any other interpretation of fences 20 and 22 would cause them to be sliced by saw blade 38 when making a maximum angle miter cut. The movable fences in **Viazanko** are also designed to provide clearance for the saw blade at its maximum angle cut as illustrated in Figure 2 with scale holder 144 and as illustrated in Figure 13 for scale holders 164 and 165, all of which in alignment with the inside edge of fixed fences 20 and 22. Thus, there is no support for having a movable fence being movable to provide clearance for the cutting tool when said cutting tool is in an angled position as is defined in Claim 1. The scale holders (movable fences) in **Viazanko** are not designed to be movable fences; they are designed to be positioned with respect to the saw blade and then fixed in that position in order to support a stop 148, which is adjustable for specific sizes of boards. See Column 5, lines 59-62, where it is discusses stop 148 by stating that when the clamp bolt is tightened, the stop 148 is clamped to the face of the index scale holder 144 (the Examiner's fence) and, thus, is not a movable fence as defined by Claim 1; it is a second fixed fence, which supports a movable stop.

In addition, dependent claims 27 and 28 define the movable fence as being movable to a position between the fixed fences and the cutting tool. There is absolutely nothing disclosed within **Viazanko** or any other of the cited references that discloses, suggests or provides incentive support for the Examiner's position of obviousness.

Regarding Claim 22, it defines that the height of the workplace supporting surface is greater than the height of the workpiece-supporting surface of the fixed fence. Figure 2 of **Viazanko** clearly shows the opposite and, thus, **Viazanko**, as well as all of the other cited prior art, does not disclose, suggest or provide incentive support to find this claim limitation obvious.

Viazanko teaches two fences on each side of the cutting tool, but both fences are designed to be fixed and both fences are designed to always provide clearance for the cutting tool at all operational angles of the power saw. There is nothing in **Viazanko** that discloses, teaches or suggests providing a movable fence that is movable to provide clearance for the cutting tool. The addition of the compound miter saw to **Viazanko** does not provide the adjustable fence of the present invention; the addition would cause the two fixed fences in **Viazanko** to be designed to always provide clearance for the saw blade when the saw blade is in any position.

Thus, Applicants believe Claims 1 and 22 patentably distinguish over the art of record. Likewise, Claims 10, 11, 14, 15, and 23-29, which ultimately depend from one of these independent claims, are also believed to patentably distinguish over the art of record.

Reconsideration of the rejection is respectfully requested.

REJOINDER

Applicants respectfully request rejoinder of Claims 2-7.

NEW CLAIMS

New Claims 30-32 are dependent claims depending from Claim 1 or Claim 22. Applicants believe Claims 30-32 read on the elected species. Support for these new claims is illustrated in Figures 6 and 10.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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